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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,878	10/20/2003	Robert M. Olgin		3901

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EXAMINER	
COLE, LAURA C	
ART UNIT	**PAPER NUMBER**
1744	

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/689,878	OLGIN ET AL.	
	Examiner	Art Unit	
	Laura C Cole	1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The use of the trademark VELCRO® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology (hook and loop fastener).

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

2. Claims 1-4 are objected to because of the following informalities:

In Claim 1 Lines 3 and 9, Claim 2 Line 5, and Claim 3 Lines 6-7 it is improper to use parentheses in a claim.

In Claim 1 Line 4 it is not clear as to what is meant by "especially".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a

manner as to present a complete operative device. *The claim(s) must be in one sentence form only.* Note the format of the claims in the patent(s) cited.

4. Claim 3 contains the trademark/trade name VELCRO®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a hook and loop fastener and, accordingly, the identification/description is indefinite.

5. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 1-4 it is unclear as to what is meant by "cloth-*like*" or "rubber-*like*".

In Claim 1 Line 5, the term "inlayed" is unclear and the Examiner is confused as to what is meant by "inlayed".

Claim 2 Lines 4-8 are confusing and unclear. The term "circumference" is especially unclear.

Claim 3 Lines 3-4 recites that the "hook or loop attachment further comprises the cloth-like and/or foam pad buffing bonnet" which is confusing. How does the attachment comprise the bonnet?

Claim 4 Lines 4-8 are confusing and unclear. It is unclear whether or not the "substrate" is an adhesive. It is unclear as to how the cloth material, the rubber-like material, and the commercial pad are intended to be configured.

6. Regarding claims 1-4, the phrase "and/or" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kitahata et al., USPN 4,965,905.

Kitahata et al. discloses the claimed invention including a buff pad attachment device for securing a bonnet (36 and 42) onto a high-speed commercial buff pad (40). The attachment device is of a rubber-like material (Column 2 Lines 63-66) that acts as a cushion and grips to a commercial pad's front surface (see Figure 2). The rubber-like material is attached atop of a cloth-like material backside (36; Column 2 Lines 57-58).

The bonnet has a circumference larger to wrap over the standard commercial buff (see Figure 2).

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Umbrell, USPN 6,081,959.

Umbrell discloses the claimed invention including a buff pad attachment device for securing a bonnet (12) onto a high speed commercial buff pad (14). The attachment device is of a rubber-like material (plastic sheets 30, 38, 40, 42, and 44) that acts as a cushion and grips to a commercial pad's front surface (see Figures 1-3). The rubber-like material is attached atop of a cloth-like material backside (16; Column 4 Lines 54-60). The bonnet has a circumference larger to wrap over the standard commercial buff (see Figure 6). The commercial pad has a back surface that has a hooked surface (60) and the attachment surface has a connecting "tab" of loops (46).

9. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Bordeaux, USPN 4,399,578.

Bordeaux discloses the claimed invention including a buff pad attachment device for securing a bonnet (18) onto a high speed commercial buff pad (15). The attachment device is of a rubber-like material (Column 2 Line 56) that acts as a cushion and grips to a commercial pad's front surface (see Figures 5 and 8). The rubber-like material is attached atop of a cloth-like material backside (19; Column 2 Lines 56-57). The bonnet has a circumference larger to wrap over the standard commercial buff (see Figure 5). In one embodiment, the cloth-like material is affixed to the rubber-like material, and the cloth-like attachment has a fabric material (52) which encases a string (54). A second

embodiment of Bordeaux has the cloth-like material affixed to a thin substrate material (22, via 20) that gives a sufficient amount of adhesion to the commercial buff pad (Column 2 Lines 41-66).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bordeaux, USPN 4,399,578.

Bordeaux discloses all elements above including the cloth-like material to be attached to a material encasement (52) that encases a string (54). Bordeaux does not specify a material (such as nylon) as to which the encasement or string are composed of.

It would have been obvious for one of ordinary skill in the art at the time the invention was made to construct the encasement and string from nylon, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. In re Leshin, 125 USPQ 416.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitahata et al., USPN 4,965,905.

Kitahata et al. disclose all elements above including the cloth-like material to be attached to a material encasement that encases a string. Kitahata et al. does not specify a material (such as nylon) as to which the encasement or string are composed of.

It would have been obvious for one of ordinary skill in the art at the time the invention was made to construct the encasement and string from nylon, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. In re Leshin, 125 USPQ 416.

12. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitahata et al., USPN 4,965,905 in view of Lelkes et al., USPN 5,533,222.

Kitahata et al. disclose all elements, however do not include the cloth like material having a webbing of which hook and loop tabs are affixed in order to attach to hook and loop fasteners on the back of the commercial buff pad.

Lelkes et al. provides a teaching of a cover for attaching to a commercial buff pad (50). The cloth-like cover (46; Figure 10) has a "webbing" that has tabs (146) that have loops (the felt fabric itself, Column 5 Lines 34-37) that communicates with a hook fastener (148) on the commercial buff pad (Column 5 Lines 31-40).

It would have been obvious for one of ordinary skill in the art to modify the attachment means of the cloth like material of Kitahata et al. to have tabs having hook and loop fasteners, as Lelkes et al. teach, in order to assemble the cloth like material, rubber pad, and commercial buffer.

Conclusion

13. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C Cole whose telephone number is (571) 272-1272. The examiner can normally be reached on Monday-Thursday, 7:30am - 5pm, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J Warden can be reached on (571) 272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LCC

LCC
17 December 2004

Robert J. Warden, Sr.

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